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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/553,251

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Georg Roeder

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EXAMINER

DOAN, ROBYN KIEU

ART UNIT

PAPER NUMBER

3732

MAIL DATE

DELIVERY MODE

03/16/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,251	Applicant(s) ROEDER, GEORG	
	Examiner Robyn Doan	Art Unit 3732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 November 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 57-116 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 57-116 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Applicant's Amendment filed 11/16/2009 has been entered and carefully considered. Claim 57 has been amended. Limitations of amend claim have not been found to be patentable over newly discovered prior art, therefore, claims 57-116 are rejected under the new ground rejections as set forth below.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the connection part (910 or 1010) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an

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application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 57, 61-101, 103-106, 111, 112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karl (EP 0038524A2) in view of Forsline (USP 5,749,117).

Karl discloses an applicator (figs. 2, 5) comprising a holding portion (1) and a hollow applicator portion (3) being formed by a casing which at least partially encloses a hollow space; the applicator having a plurality of structure elements (4) and being made of soft plastic material (page 15, claims 13, 14) and the holding portion being made of plastic material. Karl fails to show the holding portion having a holding part and whereby the applicator portion being fixed in a direction of longitudinal extent of the applicator by means of a connecting part and the holding portion extends in the longitudinal extent only till the end of the connecting part into the applicator portion. Forsline discloses an applicator (fig. 13) comprising a holding portion (122) having a holding part, an applicator portion (42) being made of rubber (col. 5, lines 42-45) being fixed in a

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direction of a longitudinal extent of the applicator by means of a connecting part (72) and a holding portion extends in the longitudinal extent only till the end (at 72, 70) of the connecting part into the applicator portion; Forsline further show the holding portion being made of harder plastic material (col. 4, line 55), the applicator portion being made of thermoplastic elastomer having a hardness of between 2 and 45 Shore A (col. 5, lines 55-65), the applicator portion tapers away from the holding portion and having at least one flattened portion (see figs. 2, 5). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the applicator of Karl with the connecting means as taught by Forsline as an alternative way of attaching the holding portion with the applicator portion. In regard to claims 62, 67, 69, 70, 73-75, 78-101, It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the applicator portion being bristles, slats, knobs, prongs, each having a different cross-section and extend perpendicular to the applicator surface between .1mm to 1mm and having a diameter between .4mm to .6mm; the casing having a thickness between .8mm and 1.3mm and an extension in the direction of the longitudinal extent of between 3mm and 7mm or 5mm to 10 mm; also the applicator portion forming an extension in the direction of longitudinal extent of less than 14mm, since such a modification would have involved a mere change in the size and shape of the known component. A change in shape and size is generally recognized as being within the level or ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955). In regard to claims 103-105, the device shown by Karl in view of

Forsline will perform the method recited in the claims during normal operational use of the device.

Claims 58-60, 106, 107-112 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karl in view of Forsline as applied to claim 57 above, and further in view of Vayrette (USP 6,672,314).

Karl in view of Forsline discloses the essential claimed invention except for a connecting layer between the holding portion and the applicator portion, wherein the connecting layer having a mixing layer. Vayrette discloses an applicator (figs. 3, 4) comprising a holding portion (102) and an applicator portion (3), a connecting layer (130) between the holding portion and the applicator portion, wherein the connecting layer having a mixing layer. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the connecting portion as taught by Karl in view of Forsline with the connecting layer as taught by Vayrette in order to better maneuver the applicator.

Claims 102, 113-116 are rejected under 35 U.S.C. 103(a) as being unpatentable over Karl in view of Forsline as applied to claim 57 above, and further in view of Hand (USP 2,140,009).

With regard to claim 102, Karl in view of Forsline discloses the essential claimed invention as discussed above except for the holding portion having metal. Hand discloses a cosmetic applicator (fig. 1) comprising a holding portion (16) being made of metal (col. 2, line 12); the device further having a cap (8). It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify the

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holding portion of Karl with the metal material as taught by Hand as an alternative way of forming the holding portion. In regard to claims 113-116, Karl in view of Forline and further in view of Hand discloses the method recited in the claims during normal operational use of the device. In regard to claims 107-110, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to inject the applicator portion onto the holding portion at a temperature between 30°C to 80°C. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct temperature between 30°C to 80°C, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Conclusion

Applicant's arguments with respect to claim 57 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 8:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez can be reached on (571) 272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robyn Doan/
Primary Examiner, Art Unit 3732

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